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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,130	11/05/2001	Patrick Raugel	OSTEONICS 3.0-322	2165
530	7590	07/14/2004	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			DAVIS, DANIEL J	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,130

Applicant(s)

RAUGEL, PATRICK

Examiner

D. Jacob Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 18-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 5 recites a planar second portion. Claim 9, line 2 recites a retainer. As claimed, the retainer appears to be a different element from the second portion. However, according to page 5, lines 17-18 and Fig. 1 of applicant's specification, the retainer and second portion appear to be the same element, resulting in a double inclusion. For purposes of examination, the retainer is considered to be element 10, the retainer is considered to be equivalent to the second portion.

Claim 10 is also indefinite. Claim 1 recites, "a support having a planar first portion...and planar second portion." Hence the support as recited in claim 1 is considered to refer to the entire device, for example as illustrated in Fig. 1, and not merely the first portion 5 as stated in the specification.

To alter the meaning of "support" as accepted in claim 1, claim 10 recites both the retainer and the support being connected. Appropriate action is required.

(Examiner would also like to point out that claim 18 recites, "a retainer having a first portion...[and] a second portion." Hence the retainer as recited in claim 18 is considered the entire device, for example as illustrated in Fig. 1, and not merely the second portion 10 as stated in the specification. Although the meaning of the terms "support" and "retainer" as recited in claims 1 and 18, respectively, do not conform to the specification, their meanings are nonetheless clear.)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 5-13, and 18-27 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,302,286 to Witherspoon.

Regarding claim 1 and its dependents, Witherspoon discloses a handling device (Figs 1-6) capable of holding a bearing liner comprising a support having a first portion 2 including means for aligning, an opening, and a deformable rim. The second portion 3 has a planar bottom rim surface. The first and second portions are capable of pivoting about any pivot point on element 26. Since element 26 is flexible, and both first portion

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2 and element 26 are made of the same material, it is concluded that the first portion 2 is also flexible.

The device is made of "a flexibly rigid plastic" (col. 5, lines 60-63). The embodiment of Fig. 5 illustrates a castellated rim. The first portion 2 comprises a means for retaining. Since the rim surface of second portion 3 is capable of pivoting and engaging the first portion 2, the rim is capable of "extend[ing] across the upper rim of the bearing liner." The device further comprises a means for retaining 26. Fig. 7 illustrates the inner opening of the retainer/first portion 3 being smaller in diameter than the outer diameter of the first portion 2.

The first portion comprises a handle, which is considered any portion of the rim of first portion 2. Fig. 5 illustrates slits extending radially outwardly from the inner perimeter of the opening. The portion of retaining means 26 residing immediately adjacent to either the first portion 2 or the second portion 3 is considered a hinged joint, which may also form part of the handle.

Claims 1-4, 7-13, 18, 20, 22 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by or in the alternative under 35 U.S.C. 103(a) as being unpatentable over Des. 353,328 to Nuffer. Nuffer discloses a handling device capable of holding a bearing comprising a first portion (the open ring) and a second portion (the filled ring). Since the device is used as a cover for a pop can, it is assumed that the open ring is deformed in order to be placed on the can. The filled ring (also deformable) is used to cover the can.

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In the alternative, it would have been obvious to one of ordinary skill in the art at the time the invention was made make the open ring deformable in order to bend around and snugly fit a pop can in order to semi-permanently attach the device to the can.

The device is substantially flat and is capable of being made from a sheet material. The first portion comprises a means for retaining. The second portion/retainer comprises an extended portion. A hinged joint connects the first and second portion.

Response to Arguments

Applicant's arguments filed April 29, 2004 have been considered but are moot in view of the new grounds of rejection. The newly found references anticipate the amended claims as described.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: U.S. Patent No. 3,924,738 to Paupitch, U.S. Patent No. 4,974,735 to Newell et al., and U.S. Patent No. 5,163,691 to Lederman.

Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

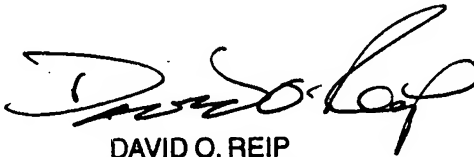
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Jacob Davis whose telephone number is (703) 305-1232. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott or Shaver can be reached on (703) 308-0858. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DJD
July 1, 2004



DAVID O. REIP
PRIMARY EXAMINER